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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>NA1P467/00.177.01</b>
I hereby certify that this correspondence is being e-filed with the USPTO  on <u>December 17, 2007</u>  Signature <u>/Dana Chan/</u>  Typed or printed <u>Dana Chan</u> name _____		Application Number <b>09/912,389</b>
		Filed <b>07.26.2001</b>
		First Named Inventor <b>Neil Andrew Cowie</b>
		Art Unit <b>2131</b>
		Examiner <b>Henning, Matthew T.</b>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record. 41,429  
Registration number \_\_\_\_\_
- attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

**/KEVINZILKA/**

Signature

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Typed or printed name

**408-971-2573**

Telephone number

**December 17, 2007**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to be had by the USPTO to process an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1490, Alexandria, VA 22313-1490.

REMARKS

The Examiner has rejected Claims 1-3, 5-8, 12, 14-19, 21-24, 28, 30-35, 37-40, 44, 46-51, 53-56, 60, 62-67, 69-72, 76, 78-83, 85-88, 92, 94-96, and 98 under 35 U.S.C. 103(a) as being unpatentable over Cozza (U.S. Patent No. 5,649,095) in view of Arnold et al. (U.S. Patent No. 5,442,699), and further in view of Pietrek (“Peering Inside the PE: A Tour of the Win 32 Portable Executable”). Applicant respectfully disagrees with such rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the aforementioned references, applicant’s arguments spanning paragraph 3 of Page 21 to paragraph 2 of Page 23 are hereby incorporated by reference.

In the Office Action mailed 09/17/2007, the Examiner has argued that “Cozza discloses that if the file requires decompression, then it is decompressed,” and that such “does not require decompression in Cozza.” In addition, the Examiner has argued that “Arnold teaches an alternative to decryption when searching for viruses in an encrypted file,” and that “[a]s such, the ordinary person skilled in the art would have been motivated to implement the teachings of Arnold in place of the decompression and searching of Cozza.” Further, the Examiner has argued that “Cozza does not teach away from the teachings of Arnold, but rather disclosed an alternative to the method of Arnold,” and that “[n]owhere in Cozza is there any teaching that would cause one of ordinary skill in the art to ignore or avoid the teachings of Arnold.”

Applicant respectfully disagrees. Cozza discloses that “[a] compressed file may have already been decompressed” but that “[i]f the file does require decompression, then it is

decompressed" (Column 7, Lines 20-24-emphasis added). In fact, Cozza only teaches that after such decompression, the file is scanned (see steps 84, 86, 90 and 94 in Figure 4D of Cozza).

Thus, Cozza expressly discloses that a compressed file requires decompression prior to being scanned.

Arnold, on the other hand, relates to "detect[ing] and locat[ing] patterns that are present within data that has been encrypted" (see Abstract-emphasis added). As even noted by the Examiner, "Arnold teaches an alternative to decryption when searching for viruses in an encrypted file." Clearly, there would have been no motivation or suggestion to combine Arnold, which only relates to searching for patterns within encrypted data, with the teachings of Cozza, which only scans compressed data after such data is decompressed. Thus, the Examiner's proposed combination is inappropriate. Similarly, searching for patterns within encrypted data, as in Arnold, does in fact *teach away* from only scanning compressed data after such data is decompressed, as in Cozza.

Thus, applicant respectfully asserts that the first element of the *prima facie* case of obviousness has not been met, as noted above. More importantly, applicant also respectfully asserts that the third element of the *prima facie* case of obviousness has not been met by the prior art reference excerpts relied on by the Examiner. For example, with respect to the independent claims, the Examiner has relied on Col. 2, lines 54-65 and Col. 6, lines 6-45 from the Cozza reference to make a prior art showing of applicant's claimed "reading resource data within said packed computer file, said resource data specifying program resource items used by said known computer program and readable by a computer operating system without dependence upon which unpacking algorithm is used by said packed computer file" (see this or similar, but not necessarily identical language in the independent claims). Applicant's arguments spanning paragraph 3 of Page 23 to paragraph 3 of Page 24 are hereby incorporated by reference.

In the Office Action mailed 09/17/2007, the Examiner has argued that "the resource fork size falls within the scope of resource data," and that "Cozza disclosed that the resource fork may include application code, icons, preferences, strings, templates, and other such items" which "all fall under resource data as well." The Examiner has further argued that "by reading the resource fork size, which is part of the resource data, Cozza has met the limitation of [applicant's] claim." Still yet, the Examiner has argued that "Cozza specifically says that this may involve

decompression, or executing some other special system or other code in order to obtain this information,” such that “Cozza disclosed that decompression was not required.”

Applicant respectfully disagrees. Only reading a resource fork size, as in Cozza, does not meet applicant’s claimed “reading resource data within said packed computer file, said resource data [that is read] specifying program resource items used by said known computer program” (emphasis added), in the context claimed by applicant. Applicant emphasizes that merely reading a size of a resource fork, where the resource fork may include application code, icons, preferences, strings, templates, and other such item, as noted by the Examiner, does not include reading the resource fork itself, as the Examiner seems to suggest, and especially does not meet applicant’s specifically claimed “said resource data [that is read] specifying program resource items used by said known computer program” (emphasis added), as claimed.

Additionally, merely alleging that Cozza discloses using decompression, or executing some other special system or other code in order to obtain this information, as noted by the Examiner, fails to even suggest “reading resource data within said packed computer file, said resource data... readable by a computer operating system without dependence upon which unpacking algorithm is used by said packed computer file” (emphasis added), in the context claimed by applicant.

Further, the Examiner has relied on Figure 5 in Cozza to make a prior art showing of applicant’s claimed technique “wherein said generated fingerprint data includes a flag indicating which data is included within said generated fingerprint data” (see this or similar, but not necessarily identical language in the independent claims). Applicant’s arguments spanning paragraph 2 of Page 26 to paragraph 1 of Page 27 are hereby incorporated by reference.

In the Office Action mailed 09/17/2007, the Examiner has argued that “the claim language does not require that the flag indicates all of the data that was included in the generated fingerprint data,” and that “[e]ach set of flags of Cozza indicates which viruses are contained within a specific file.” The Examiner has further argued that “the file data is used to generate the hash portion of the fingerprint,” and that “[t]he flags indicate which viruses, and thus which data, was included in the file data which is hashed, which falls within the scope of the claim language.”

Applicant respectfully disagrees. Cozza only discloses that the flag is included in a scan information cache file that "includes data that has been accumulated during the scanning of files" (Col. 5, lines 17-21). Clearly, a flag included in such a scan information cache file, as in Cozza, does not meet applicant's claimed technique "wherein said generated fingerprint data includes a flag indicating which data is included within said generated fingerprint data" (emphasis added), particularly when "said generated fingerprint data includes a number of program resource items specified within said resource data of said packed computer file," in the context claimed.

Still yet, with respect to the independent claims, the Examiner has relied Col. 6 lines 29-45 from the Cozza reference to make a prior art showing of applicant's claimed technique "wherein said generated fingerprint data includes a location within said resource data of said packed computer file of an entry specifying a program resource item having a largest size" (see this or similar, but not necessarily identical language in the independent claims). Applicant's arguments spanning paragraphs 2-4 of Page 27 are hereby incorporated by reference.

In the Office Action mailed 09/17/2007, the Examiner has argued that "[b]ecause the file contains the resource fork and resource items, and the hash is taken of the file, the signature includes a number of resource items specified within the resource fork, including the location of the entries of the resource items, including the largest resource item." In addition, the Examiner has argued that "[s]imilarly, because the hash is of the file, the hash includes all locations within the file."

Applicant respectfully disagrees. Simply because a file allegedly contains the resource fork, as noted by the Examiner, does not inherently suggest that "said generated fingerprint data includes a location within said resource data of said packed computer file of an entry specifying a program resource item having a largest size" (emphasis added), as specifically claimed by applicant.

Moreover, with respect to the independent claims, the Examiner has relied on Figure 5 from Cozza and Page 21, "PE File Base Relocations" in Pietrek to make a prior art showing of applicant's claimed technique "wherein said generated fingerprint data includes a checksum value calculated in dependence upon: a number of program resource items specified beneath

each node within hierarchically arranged resource data of said packed computer file" (see this or similar, but not necessarily identical language in the independent claims). Applicant's arguments spanning paragraph 1 of Page 28 to paragraph 1 of Page 29 are hereby incorporated by reference.

In the Office Action mailed 09/27/2007, the Examiner has relied upon "the 'hash', as taught by Arnold, in the combination, as meeting the limitation of the checksum, and not the checksum of the cache disclosed by Cozza."

Applicant respectfully disagrees and asserts that that even the combination with Arnold does not meet applicant's specific claim language. For example, Arnold's mere disclosure of using a hashing function (Col. 10, lines 48-53), in addition to Pietrek's general disclosure of a resource directory hierarchy does not specifically teach a technique "wherein said generated fingerprint data includes a checksum value calculated in dependence upon: a number of program resource items specified beneath each node within hierarchically arranged resource data of said packed computer file" (emphasis added), as claimed by applicant.

Applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness have not been met, since it would be *unobvious* to combine the references, as noted above, and the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.